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P A T E N T
Communication *K. Luell*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David A. Russo, et al. *5000-94* Group Art Unit:
Serial No.: 08/104,125 Examiner:
Filed: 08/16/93
For: Coating Composition for Glass
International Application No. PCT/US92/10873
International Application Filing Date 12/21/92
Attorney Docket: 3224C

Philadelphia PA 19103-3222
January 18, 1994

COMMUNICATION

Box PCT
Hon. Commissioner of Patents and Trademarks
Washington DC 20231

Sir:

Applicants respectfully traverse the holding and requirements set forth in the communication entitled "Notification of a Defective Response," Form PCT/DO/EO/916 (the 916 form), with the accompanying Form PTO-152, mailed from the Patent and Trademark Office (PTO) under date of 01/04/94 in the captioned case. That communication represents that the declaration responsive to the Notification of Missing Requirements Under 35 USC 371 in the United States Designated/Elected Office, Form PCT/DO/EO/905, (1) was not timely filed, and (2) did not comply with 37 CFR 1.63 in that it "... does not identify the foreign application for patent or inventor's certificate on which priority is claimed ...".

In answer to the representation that the response was not timely, Applicants note the following:

(a) The time for response to Form PCT/DO/EO/905 is set forth in bold capitals between numbered paragraphs 3 and 4 on that form. That requirement reads in full as follows:

ALL THE ITEMS SET FORTH IN 2(a) - 2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN *ONE MONTH* FROM THE DATE OF THIS NOTICE OR BY ☐ 21 or ☐ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, *WHICHEVER IS LATER*. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. (Emphasis supplied herein.)

A response to the requirements of Form PCT/DO/EO/905, mailed from the PTO on 11/16/93, in order to be timely by the terms of that document, would therefore have to be filed not later than 12/16/93.

The stamped date of mailing of the Form PCT/DO/EO/905 in this case was 11/16/93; the filing date of Applicant's response to that communication, as acknowledged by the PTO on the 916 form, was "DEC 13 1993". Thus, the form 916 shows on its face that the required response was filed three days *prior* to the one-month time period granted to Applicants under the stated terms of the Form PCT/DO/EO/905, and was physically received in the PTO *on* the due date. Under any interpretation of PTO rules, the response was timely.

The form 916 acknowledges further that Applicants had supplied the required surcharge under 37 CFR 1.492(f).

Applicants respectfully suggest that their response to the requirements of Form PCT/DO/EO/905 was timely in all respects.

(b) In specific comment on the statement on the form 916 that Applicants have not identified a material foreign case, Applicants note that no foreign cases of any kind are involved in the history of this application. A number of national-phase foreign cases have been filed, subsequent to, and based upon, the PCT application herein, PCT/US/92/10873; however, the parent cases, on which the priority of this application is based, are United States applications, Serial Numbers 07/814,352 and 07/814,366, both filed 12/27/91; these cases led to the filing of International Application Number PCT/US92/10873, International Filing Date 12/21/92. This present application, SN 08/104,125, was filed as the United States national-phase case based upon PCT/US92/10873, and was filed on 08/16/93.

Applicants, in their declaration filed on December 13, 1993, stated in terms, *inter alia*,

... that this application in part discloses and claims subject matter disclosed in our *earlier-filed copending United States applications*, Serial Numbers 07/814,366 and 07/814,352,...

... that the common *subject matter has not been patented or made the subject of an inventor's certificate* issued before the date of the earlier applications *in any country foreign to the United States of America* on an application filed by us or our legal representatives or assigns more than twelve months prior to the earlier application; and that *no application for patent or inventor's certificate on that invention had been filed by us or our representatives or assigns in any country foreign to the United States of America*;...

... and that *said subject matter has not been patented or made the subject of an inventor's certificate issued in any country foreign to the United States of America* on an application filed by us or our legal representatives or assigns more than twelve months prior to the date of this application; and that no application for patent or inventors' certificate on said invention has been filed by us or our representatives or assigns in any country foreign to the United States of America. (Emphasis supplied herein.)

Applicants have made no claim for foreign priority, either under 35 USC 119 or 172, and suggest that the cited and emphasized portions of their declaration show clearly that the statement in the Form 152 is incorrect. The term "37 CFR 1.55" does not appear anywhere in the family of which the present application is a part, nor do any terms relating to foreign priority, except, as stated above, in the negative.

Applicants note a further matter of confusion in the form 916, in that it indicates, under the paragraph numbered 3, that on December 16, 1993, the PTO had received a copy of the international application in English. It is correct that the PTO received a copy of the international application, written in English, but the PTO received that application on 12/22/92. Only the specification of that application, appended to the declaration, was included with Applicants' response filed 12/13/93. However, the form 916 also purports to suggest that the "translation" was defective, as indicated by the marking in the box entitled

"Notice of Defective Translation" at the end of the form 916. Applicants have no record of receipt of that Notice.


In order to facilitate review of the present matter, Applicants include with this communication true copies of the face sheet of the international filing in PCT/US92/10873, and the form 916. The return copy of Form PTO-152 is also included. The face of the international-filing sheet shows the priority data relating to two United States cases; Form PTO-152 has paragraph 5 marked to set forth the statement that the declaration did not identify foreign-application data; and the form 916 contains acknowledgement of receipt on DEC 16 1993 of "Applicants' response, *filed* DEC 13 1993"... , to the " ... notification mailed NOV 16 1993." (Emphasis supplied herein.)

Although Applicants suggest that no further fee is required in this matter, they request that if necessary, the Commissioner charge Deposit Account Number 01-2717 for any additional fees which may be due, for other than a small entity. A duplicate copy of this request is enclosed.

Elf Atochem North America, Inc.
2000 Market Street
Philadelphia PA 19103-3222

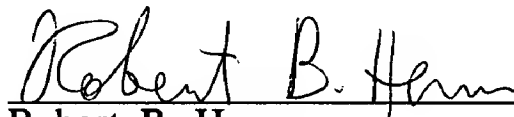
215 419 7792

Respectfully submitted,
David A. Russo, et al.

By 
Robert B. Henn
Reg. No. 25,630
Their Attorney

CERTIFICATE OF MAILING

This is to certify that the accompanying communication in the captioned case was deposited in the United States mail in an envelope addressed to Box PCT, Hon. Commissioner of Patents and Trademarks, Washington DC 20231, with proper first-class postage affixed, on this 18th day of January, 1994.


Robert B. Henn
Reg. No. 25,630

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